

## REMARKS

This is intended as a full and complete response to the Final Office Action dated December 12, 2007, having a shortened statutory period for response set to expire on March 12, 2008. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-7, 10, 13-15, 17, 18, 23, 24, 26, 28, 29, 31, 33 and 34 are pending in the application. Claims 1-7, 10, 13-15, 17 and 18 remain pending following entry of this response. Claims 23, 24, 26, 28, 29, 31, 33 and 34 have been cancelled.

### Claim Rejections - 35 U.S.C. § 102

Claims 1-7, 10, 13-15, 17, 18, 23, 24, 26, 28, 29, 31, and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by *Newell et al.* (U.S. Patent No. 5,159,560, hereinafter, "*Newell*").

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Newell* does not disclose "each and every element as set forth in the claim". Applicants have argued that *Newell* does not disclose "receiving, at the vending machine, a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item, whereby a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine." The Examiner rejects

this argument and maintains that *Newell* discloses the claim element in the abstract, at col. 3, lines 42-67, col. 4, lines 30-59 and col. 13 – col. 15. See Final Office Action, pages 5-6. The Examiner argues that because *Newell* allows a number of vending machines, operating in diverse locations, to be used for dispensing and retrieving articles while allowing an article acquired from one vending machine to be returned to another in the system, it is inherent to recognize that the system in *Newell* is capable of checking availability of one other vending machine. See Final Office Action, page 6.

As an initial matter, Applicants point out that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See *MPEP* Sec. 2112. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See *id.*

In this case, it does not follow that the system in *Newell* is inherently capable of checking availability of one other vending machine. *Newell* merely updates the location of the item in the networked inventory when an item is returned to a machine. There is no mechanism in *Newell* by which a vending machine receives "a response to the request indicative of whether the item is available in at least one other vending machine configured to dispense the item when stocked with the item." Even assuming the network in *Newell* knows which vending machine the item (e.g. videocassette) is located at (i.e. check availability), the vending machine in *Newell* does not give the user information by which "a user can retrieve the item at the at least one other vending machine when the item is available at the at least one other vending machine."

Additionally, *Newell* does not disclose "in response to receiving the purchase order, transmitting a request for the item via a network connection established through a

network interface of the vending machine.” Applicant points out that the Examiner provides no citation to *Newell* for teaching this element.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. McClellan, Reg. No. 44,227/

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